



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/992,914	12/18/97	WATANABE	E 0020-4348P

HM12/0609  
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EXAMINER

ZAGHMOUT, O

ART UNIT

PAPER NUMBER

1649

13

DATE MAILED:

06/09/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/992,914**

Applicant(s)  
**Watanabe et al.**

Examiner  
**Ousama Zaghmout**

Group Art Unit  
**1649**



☒ Responsive to communication(s) filed on Mar 4, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-42 is/are pending in the application.

Of the above, claim(s) 19-29, 37-39, and 42 is/are withdrawn from consideration.

☒ Claim(s) 1-4, 6, 7, 9-18, 30-36, 40, and 41 is/are allowed.

☒ Claim(s) 5 and 8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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**Detailed Action**

Claims 1-42 are pending.

Claims 1-9, 21-23, 29 have been amended.

Claims 40-42 have been newly added by the amendment. Claims 19-29, 37-39, 42 are still withdrawn from considerations as they are drawn into a non-elected inventions.

The CRF submitted by the applicants is technically bad. A notification of a failure to comply with the sequence rules is accompanied by an analysis of a submitted computer readable form. Any inquiries regarding a specific computer readable form that has been processed by the Office should be directed to the Systems Branch of the Chemical/Biotechnology Division of the Scientific and Technical Information Center.

The declaration submitted by Dr. Watanabe was considered and found to be helpful in resolving the issue of enablement which was raised by the Examiner in the previous Office Action. However, this declaration did not contain sufficient information to overcome the rejection of claims 5 and 8 under 112 2nd as listed below.

**Claim Rejections - 35 U.S.C. § 112**

**2nd Paragraph**

Claims 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 5 and 8 remain rejected as being vague and indefinite in failing to clearly define the metes and bounds of the claims for the same reasons set forth in the previous Office Action.

Applicants argue that “the language of the claims is sufficiently definite to allow one of ordinary skill in the art to determine if an activity that they contemplate lies inside or outside the scope of the claim” [ paragraph 3, page 10]. The Examiner respectfully disagrees. The sequence of the claimed protein encompassed by subparagraph (b) is not adequately defined. These designated alterations “deletion, replacement, modification or addition” to SEQ ID Nos: 1 and 3 are not defined by the specification. The specification does not provide a standard for ascertaining the requisite degree of these said alterations, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### **Conclusion**

Claims 1-4, 6-7, 9-18, 30-36, 40-41 are deemed free of the prior art given the failure of the prior art to teach or suggest the particularly claimed DNA sequence and their usage in transformation experiments.

Claims 1-4, 6-7, 9-18, 30-36, 40-41 are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.

June 6, 1999

  
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